IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

re patent application of:	) Date: June 21, 2004
Douglas B. Quine	) Attorney Docket No.: F-179
Serial No.: 09/629,904	) Customer No.: 00919
Filed: July 31, 2000	) Group Art Unit: 2141
Confirmation No.: 5067	) Examiner: Djenane M. Bayard

Title: E-MAIL FORWARDING SYSTEM HAVING ARCHIVAL DATABASE

TRANSMITTAL OF APPEAL BRIEF (PATENT APPLICATION 37 CFR 1.192)

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Transmitted herewith in **triplicate** is the **APPEAL BRIEF** in the above-identified patent

application with respect to the Notice of Appeal filed on April 21, 2004.

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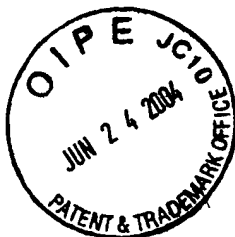
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Respectfully submitted,

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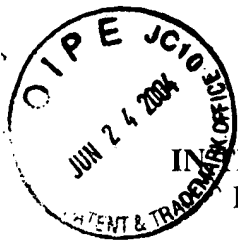
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
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In re Patent Application of:)Attorney Docket No.: F-176

Douglas B. Quine)Group Art Unit: 2141

Serial No.: 09/629,909)Examiner: Djenane M. Bayard

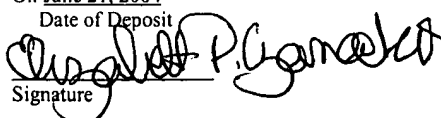Filed: July 31, 2000)Date: June 21, 2004

Confirmation No.: 5067

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APPELLANTS' BRIEF ON APPEAL

Sir:

This is an appeal pursuant to 35 U.S.C. § 134 and 37 C.F.R. §§ 1.191 et seq. from the final rejection of claim 13 of the above-identified application mailed January 23, 2004. The fee for submitting this Brief is $330.00 (37 C.F.R. § 1.17(c)). Please charge Deposit Account No. **16-1885** in the amount of $330.00 to cover these fees. The Commissioner is hereby authorized to charge any additional fees that may be required or credit any overpayment to Deposit Account No. **16-1885**. Enclosed with this original are two copies of this brief.

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REAL PARTY IN INTEREST

The real party in interest in this appeal is Pitney Bowes Inc., a Delaware corporation, the assignee of this application.

RELATED APPEALS AND INTERFERENCES

There are no appeals or interferences known to Appellants, their legal representative, or the assignee that will directly affect or be directly affected by or have a bearing on the Board's decision in this appeal.

STATUS OF CLAIMS

The instant application was filed with claims 1-16. In the Preliminary Amendment dated August 9, 2002, claims 1-16 were canceled in favor of newly added claims 17-36. In the amendment dated December 9, 2003, claims 33, 35 and 36 were canceled and claims 17, 24, 31, 32 and 34 were amended. In an amendment dated April 21, 2004, claim 34 was requested to be canceled. Accordingly, claims 17-32 are currently pending with claims 17, 24, 31 and 32 being independent.

Pursuant to the Final Office Action dated January 22, 2004, the claims stand rejected as follows:

A.   Claims 17-32 stand rejected under 35 USC 103 as being obvious over U.S. Patent No. 6,438,583 to McDowell et al. (the '583 patent) in view of U.S. Patent No. 5,805,810 to Maxwell (the '810 patent) in further view of U.S. Patent No. 6,075,844 to Goldberg et al. (the '844 patent); and

B.   Claim 34 stands rejected under 35 USC 103 as being obvious over the '583 patent in view of U.S. Patent No. 6,405,243 B1 to Nielsen.

STATUS OF AMENDMENTS

The only pending amendment to the claims filed subsequent to the final rejection dated January 22, 2004 is the cancellation of claim 34. Therefore, the claims as set forth in Appendix A to this brief are those as set after the final rejection with the exception of claim 34 being omitted.

SUMMARY OF INVENTION

The claims of the instant application relate to a method for forwarding an e-mail message intended to be delivered to a previously-known recipient e-mail address to a preferred e-mail address in the event the previously-known recipient e-mail address is disfavored. An e-mail forwarding computer is located at an intermediate-mail address, separate and apart from the sender's and previously-known recipient e-mail address, which e-mail forwarding computer is programmable to associate disfavored e-mail addresses with a preferred e-mail address (e.g., forwarding e-mail addresses).

In operation, a sender at a sender's computer sends an e-mail message to a previously-known recipient e-mail address associated with an intended recipient. And if this previously-known recipient e-mail address is disfavored (e.g., it is no longer a valid e-mail address), it is caused to be returned back to the sender's address (e.g., sender's computer). In order to find a preferred address for the intended recipient (e.g., a valid forwarding e-mail address for the intended recipient), the sender resends the e-mail from the sender's address (e.g., sender' computer) to a remote e-mail forwarding computer located at an intermediate address. Upon receipt of this e-mail message at an e-mail forwarding computer located at the intermediate address, the e-mail forwarding computer parses the disfavored e-mail address from the e-mail message to determine if there is a preferred (e.g., forwarding) e-mail address stored in the e-mail forwarding computer at the intermediate address that is associated with the disfavored e-mail address.

If there is not a match, the e-mail forwarding computer at the intermediate address stores in an archival database at least the disfavored e-mail address if it is determined that there is no preferred (e.g., forwarding) e-mail address associated with the disfavored e-mail address wherein the e-mail computer at the intermediate address subsequently checks after each new subscriber registration and address registration if a preferred (e.g., forwarding) e-mail address has been stored in the e-mail computer located at the intermediate address, which preferred e-mail address is associated with the now stored disfavored e-mail address. If there is such a match, the e-mail computer at the intermediate address than sends at least a message to the preferred address that a sender at a sender's e-mail address attempted to send an e-mail message to the disfavored e-mail address associated with the preferred e-mail forwarding address.

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Thus, an advantage of the present invention is that there is no cooperation needed by the e-mail server associated with the disfavored e-mail address. That is, if an e-mail address becomes disfavored (e.g., it is no longer an active e-mail address) either because the associated e-mail server ceases to exist, or the e-mail account has been left abandoned for a host of reasons, the present invention e-mail forwarding system nevertheless operates because no cooperation is needed from the later e-mail server. An additional benefit is that when a new subscriber registers a disfavored (e.g., no longer valid) e-mail address that was once associated with the subscriber, because of the storage of disfavored e-mail address in the archival database, the subscriber may be notified of previous attempts by senders to communicate with the subscriber, enabling that subscriber to reach out to those sender's.

ISSUES

A. Whether the subject matter defined in claims 17-22, 24-29, 31 and 32 is rendered obvious by the '583 patent in view of the '810 patent, in further view of the '844 patent.

B. Whether the subject matter defined in claims 23 and 30 is rendered obvious by the '583 patent in view of the '810 patent, in further view of the '844

GROUPING OF CLAIMS

Claims 17- 32 are grouped are grouped in the following groups:

Group I – claims 17-22, 24-29, 31 and 32.

Group II – claims 23 and 30.

ARGUMENT

As Appellant discusses in detail below, the final rejection of claims 17-32 are devoid of any factual or legal premise that supports the position of unpatentability. It is respectfully submitted that the rejection does not even meet the threshold burden of presenting a prima facie case of unpatentability. For this reason alone, Appellants are entitled to grant of a patent. In re Oetiker, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992).

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A.   The subject matter defined in claims 17-22, 24-29, 31 and 32 is not rendered obvious by the '583 patent in view of the '810 patent, in further view of the '844 patent.

In formulating this argument, reference is first made to independent claim 24 (it is submitted independent claims 17, 31 and 32 include similar recitations), which recites the following:

> A method for transmitting an e-mail message that has been sent from a sender address to a previously-known recipient e-mail address and rejected at the previously-known recipient e-mail address and transmitted back to the sender address, the method comprising the steps of:
> receiving the rejected e-mail message at an intermediate address;
> determining a preferred recipient e-mail address from the rejected e-mail message; and
> storing, at a location associated with the intermediate address, the previously-known recipient e-mail address when it is determined that there is no preferred recipient e-mail address associated with the previously-known recipient e-mail address.

Thus, in summarizing the recitations of claim 24:

- an email is transmitted from a sender's address ("an e-mail message that has been sent from a sender address to a previously-known recipient e-mail address");

- "rejected at the previously-known recipient e-mail address";

- the e-mail is then "transmitted back to the sender address";

- from the sender's address, the rejected e-mail is sent to and "received at an "intermediate address"

- at the intermediate address, a determination is made as to whether a preferred recipient e-mail address exist for the rejected e-mail;

- if no preferred recipient e-mail address exist for the rejected e-mails then the previously-known recipient e-mail address is stored "at a location associated with the intermediate address."

In the rejection of these claims, the examiner states: the 583 patent "failed to disclose storing at a location associated with intermediate address, the non-preferred e-mail address when it is determined that there is no preferred e-mail address data associated with the non-preferred e-

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mail data." In an attempt to overcome this deficiency of the '583 patent, the examiner applies the '810 patent and asserts the '810 patent "teaches storing at a location the non-preferred e-mail address data when it is determined that there is no preferred e-mail address data associated with the non-preferred e-mail address data." For support, the examiner references col. 1, lines 38-41 of the '810 patent.

The examiner then further admits: the "['583 patent] in view [the '810 patent] fails to teach wherein the e-mail message having been previously transmitted to an invalid e-mail address and transmitted back to a sender e-mail address." In an attempt to overcome this deficiency of the '583 and '810 patents, the examiner applies the '844 patent and asserts the '844 patent "teaches wherein the e-mail message having been previously transmitted to an invalid e-mail address and transmitted back to a sender e-mail address." For support, the examiner references col. 7, lines 30-36 of the '844 patent.

As now explained, neither the '810 patent, nor the '844 patent, teach or suggest what the examiner purports they do.

First, with respect to the '810 patent, this reference relates to a system and method for generating mail objects (e.g., printed postal mail) from e-mail messages. Col. 1, lines 38-41 of the '810 patent merely explains conventional e-mail architecture wherein if a recipient's e-mail client is not online or connected to an e-mail server that just received an e-mail for the recipient, "the server stores the email message until it can be viewed by the recipient." To put simply, the '810 patent teaches of temporarily storing email messages until the recipient comes online to retrieve them. This certainly does not teach or suggest, "storing previously-known recipient e-mail address when it is determined that there is no preferred recipient e-mail address associated with the previously-known recipient e-mail address" wherein the "previously-known recipient e-mail address" was "rejected at the previously-known recipient e-mail address."

For at least this reason, the '810 patent does not overcome the deficiencies of the '583 patent in teaching or suggesting storing at a location the non-preferred e-mail address data when it is determined that there is no preferred e-mail address data associated with the non-preferred e-mail address data.

Now with respect to the '844 patent, this reference relates to a messaging system that converts spoken messages into digital electronic messages. A proper reading of the '844 patent reveals that it neither teaches nor suggests processing a rejected e-mail that was returned from a recipient's PC. For instance, with respect to col. 7, lines 11-12 of the '844 patent, what is

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actually taught is that when a sender's PC sends a message to a recipient, it also sends a message back to the sender "so the sender is able to determine whether the message was correctly sent to the intended recipient." In other words, a determination is made as to whether the sender's PC correctly identified who the intended recipient is. This has nothing to do with processing an e-mail message "at a second address" for an "e-mail message having been previously rejected at the non-preferred e-mail address." Similarly, with respect to col. 7, lines 30-38 of the '844 patent, what is actually taught is that the system sends a message back to the sender that it "is not able to determine who the recipient for the message is because either the speech recognition software could not recognize the identification information . . . or no routing access code was contained in the database for the intended recipient . . ." Again, this clearly does not teach or suggest of processing an e-mail message at a "second address" that determines if there is a favored e-mail address for forwarding that e-mail message. In other words and to put simply, the '844 patent does not teach or suggest of having anything to do with processing previously rejected e-mail as is only concerned with generating original messages by converting verbal messages into electronic messages.

For at least this reason, the '844 patent does not teach or suggest of processing rejected previously transmitted e-mail messages at a second address and thus does not overcome the noted shortcomings of the '583 and '810 patents. Accordingly, it is submitted that independent claims 17, 24, 31 and 32 are allowable over the '583 patent in combination with the '810 and '844 patents.

With regards to remaining claims 18-22 and 25-29, since each of these claims depend respectively from either of independent claims 17 or 24 as addressed above, they are likewise allowable over the cited art of record for the reasons set forth above.

For at least the above reasons, Appellant respectfully submits that the final rejection of claims 17-22, 24-29, 31 and 32 is in error and should be reversed.

B.   The subject matter defined in claims 23 and 30 is not rendered obvious by the combination of the '583 and '844 patents in view of the '810 patent

In the final rejection, the examiner admits that the '583 and '844 patent, do not "disclose the storing step further comprising the step of storing the non-preferred e-mail address data until a recipient registers the preferred e-mail address data."

In an attempt to overcome this noted deficiency of the '583 and '844 patents, the examiner combines them with the '810 patent. The examiner alleges the '810 patent "discloses the storing step further comprising the step of storing the non-preferred e-mail address data until a recipient registers the preferred e-mail address data." For support, the examiner again references col. 1. lines 38-41 of the '810 patent.

As stated previously, this portion of the '810 patent merely teaches of temporarily storing email messages until the recipient comes online to retrieve them. Clearly it neither teaches nor suggests "storing the non-preferred e-mail address data until a recipient registers the preferred e-mail address data" as is recited in claims 23 and 30. Nor would the '810 patent have any reason to do so since it clearly does not relate to an e-mail forwarding system in which a subscriber registers an e-mail forwarding address in association with a now invalid e-mail addresses.

For at least this reason, Appellant respectfully submits that the final rejection of claims 23 and 30 is in error and should be reversed.

IX. CONCLUSION

In Conclusion, Appellants respectfully submit that the final rejection of claims 17-32 is in error for at least the reasons given above and should, therefore, be reversed.

Respectfully submitted,

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APPENDIX A

17. A method for transmitting an e-mail message comprising the steps of:

receiving the e-mail message at an intermediate address, the e-mail message including non-preferred e-mail address data, the e-mail message having been previously transmitted to an invalid e-mail address and transmitted back to a sender e-mail address;

parsing the non-preferred e-mail address data from the e-mail message at the intermediate address and determining if there is preferred e-mail address data associated with the non-preferred e-mail address data; and

storing, at a location associated with the intermediate address, the non-preferred e-mail address data when it is determined that there is no preferred e-mail address data associated with the non-preferred e-mail address data.

18. The method as recited in Claim 17, further comprising the step of:
transmitting the e-mail message to the preferred e-mail address when preferred e-mail address data is associated with the non-preferred e-mail address data.

19. The method as recited in Claim 18, further comprising the step of sending a return e-mail message to a sender address from the intermediate address indicating that the e-mail message has been sent to the preferred e-mail address.

20. The method as recited in Claim 17, further comprising the step of sending a return e-mail message to a sender address from the intermediate address indicating that the e-mail message was not forwarded to the preferred e-mail address.

21. The method as recited in Claim 20, further comprising indicating to the sender that the intermediate address will withdraw the e-mail message upon receiving a request from the sender address.

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22. The method as recited in claim 17, further comprising the step of transmitting an e-mail message to the preferred e-mail address indicating that a user at a sender e-mail address is attempting to transmit an e-mail message to the non-preferred e-mail address.

23. The method as recited in Claim 17, wherein the storing step further comprising the step of: storing the non-preferred e-mail address data until a recipient registers the preferred e-mail address data.

24. A method for transmitting an e-mail message that has been sent from a sender address to a previously-known recipient e-mail address and rejected at the previously-known recipient e-mail address and transmitted back to the sender address, the method comprising the steps of:

receiving the rejected e-mail message at an intermediate address;

determining a preferred recipient e-mail address from the rejected e-mail message; and

storing, at a location associated with the intermediate address, the previously-known recipient e-mail address when it is determined that there is no preferred recipient e-mail address associated with the previously-known recipient e-mail address.

25. The method as recited in Claim 24, further comprising the step of: transmitting the e-mail message to the preferred recipient e-mail address when a preferred recipient e-mail address is associated with the previously-known recipient e-mail address.

26. The method as recited in Claim 24, further comprising the step of sending a return e-mail message to a sender address from the intermediate address indicating that the e-mail message has been sent to the preferred recipient e-mail address.

27. The method as recited in Claim 24, further comprising the step of sending a return e-mail message to a sender address from the intermediate address indicating that the e-mail message was not forwarded to the preferred recipient e-mail address.

28. The method as recited in Claim 27, further comprising indicating to the sender that the intermediate address will withdraw the e-mail message upon receiving a request from the sender

address.

29. The method as claimed in Claim 24 further comprising the step of transmitting an e-mail message to the preferred recipient e-mail address indicating that a user at a sender e-mail address is attempting to transmit an e-mail message to the previously-known recipient e-mail address.

30. The method as recited in Claim 24, wherein the storing step further comprising the step of : storing the non-preferred e-mail address data until a recipient registers the preferred e-mail address data.

31. A method for transmitting an e-mail message that was sent from a sender address to a previously-known recipient e-mail address that is associated with a first service provider, and rejected at the previously-known recipient e-mail address and transmitted back to the sender address, the method comprising the steps of:

receiving the rejected e-mail message at a second address;

determining whether there is a preferred recipient e-mail address, that is associated with a second service provider, from the rejected e-mail message; and

storing, at a location associated with the intermediate address, the previously-known recipient e-mail address when it is determined that there is no preferred recipient e-mail address associated with the previously-known e-mail address.

32. A method for transmitting an e-mail message that has been sent from a sender address to a second address, rejected at the second address and transmitted back to the sender address, the e-mail message including a non-preferred e-mail address associated with a first service provider, the method comprising the steps of:

receiving the e-mail message at an intermediate address;

parsing the e-mail message to obtain the non-preferred e-mail address from the e-mail message;

determining whether there is a preferred e-mail address, that is associated with a second service provider, from the non-preferred e-mail address; and

storing, at a location associated with the intermediate address, the non-preferred recipient

e-mail address when it is determined that there is no preferred recipient e-mail address associated with the non-preferred e-mail address.

34. A method for transmitting an e-mail message comprising the steps of:

sending a first e-mail message from a sender address to a non-preferred recipient e-mail address; and

receiving, at the sender address, a second e-mail message from a second address, which is independent from the non-preferred e-mail address, indicating that the non-preferred recipient e-mail address is not preferred and that there is not a preferred recipient e-mail address associated with the non-preferred e-mail address.